

**Application No.: 10/573,877**

**REMARKS**

Claim 9 is objected to for minor informalities. It is respectfully submitted that the enclosed amendment obviates the alleged informalities. Accordingly, it is respectfully requested that this objection be withdrawn.

Claims 1, 7 and 9 are independent. It is respectfully submitted that neither JP '627 nor Hashimoto et al. '332 ("Hashimoto"), alone or in combination, disclose or suggest the claimed combinations.

Claim 1 recites in pertinent part, "recesses are formed, each of which is defined by the component side of the wiring board and the adjacent two reflectors arranged at both sides of each of the light emitting elements, and the recess has side walls in the longitudinal direction of the wiring board and *does not have side walls in the width direction of the wiring board intersecting with the longitudinal direction*" (emphasis added). Claim 9 recites a similar feature and the method of claim 7 can effect a similar structure. According to one aspect of the present invention, a novel and non-obvious arrangement can be realized in which reflectors are provided only at two sides along a direction of the light emitting device so that there is no interruption at two sides, hence leaving them open, *in the width direction* of the wiring board.

In direct contrast, Hashimoto discloses recesses which are completely surrounded by side walls. Specifically, Hashimoto discloses an LED chip 1 mounted in a housing recess 11b *which is surrounded by an MID* (Molded Interconnected Device) substrate 60 (see Fig. 4; col. 7, line 41 of Hashimoto refers to the MID as a three-dimensional molded circuit board). According to Hashimoto, the resulting resin-filled portion 62b has a circular shape so that the MID substrate

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60 completely surrounds the LED chip 1, whereby *none* of the sides of the LED chip 1 are open much less the sides in the width direction of the wiring board.

As anticipation under 35 U.S.C. § 102 requires that each and every element of the claim be disclosed, either expressly or inherently (noting that "inherency may not be established by probabilities or possibilities", *Scaltech Inc. v. Retec/Tetra*, 178 F.3d 1378 (Fed. Cir. 1999)), in a single prior art reference, *Akzo N.V. v. U.S. Int'l Trade Commission*, 808 F.2d 1471 (Fed. Cir. 1986), based on the forgoing, it is submitted that cited prior art does not anticipate claims 1, 7 and 9, nor any claim dependent thereon. The Examiner is directed to MPEP § 2143.03 under the section entitled "All Claim Limitations Must Be Taught or Suggested", which sets forth the applicable standard for establishing obviousness under § 103:

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. (citing *In re Royka*, 180 USPQ 580 (CCPA 1974)).

In the instant case, the pending rejection does not "establish *prima facie* obviousness of [the] claimed invention" as recited in claims 1, 7 and 9 because the proposed combination fails the "all the claim limitations" standard required under § 103.

Under Federal Circuit guidelines, a dependent claim is nonobvious if the independent claim upon which it depends is allowable because all the limitations of the independent claim are contained in the dependent claims, *Hartness International Inc. v. Simplimatic Engineering Co.*, 819 F.2d at 1100, 1108 (Fed. Cir. 1987). Accordingly, as the independent claims are patentable for the reasons set forth above, it is respectfully submitted that all claims dependent thereon are also patentable. In addition, it is respectfully submitted that the dependent claims are patentable based on their own merits by adding novel and non-obvious features to the combination.

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Based on the foregoing, it is respectfully submitted that all pending claims are patentable over the cited prior art. Accordingly, it is respectfully requested that the rejections under 35 U.S.C. § 102/103 be withdrawn.

### **CONCLUSION**

Having fully responded to all matters raised in the Office Action, Applicants submit that all claims are in condition for allowance, an indication for which is respectfully solicited. If there are any outstanding issues that might be resolved by an interview or an Examiner's amendment, the Examiner is requested to call Applicants' attorney at the telephone number shown below.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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